UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,895	10/15/2001	Cheol-Woong Lee	205,328	3472

7590 01/27/2004

ABELMAN FRAYNE & SCHWAB
Attorneys at Law
150 East 42nd Street
New York, NY 10017

EXAMINER	
YOUNG, JOHN L	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,895	Applicant(s) Cheol-Woong et al.
	Examiner John Young	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Oct 15, 2001* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-10* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1-22-04

FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claim 1 is rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

As per claim 1, as drafted said claim is limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*,

167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

In this case, the claim language is merely non-functional descriptive material disembodied from technological arts. For example the "communication network" interpreted broadly reads on the US Postal system, i.e., letter mail communication network of post offices.

CLAIM REJECTION — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. §103(a) as being obvious over Cookson US 6,591,365 (Jul. 08, 2003) [US f/d: 01/ 06/2000] (herein referred to as "Cookson") and further in view of Rodriguez US 6,650,761 (Nov. 18, 2003) [US f/d: 06/29/1999] (herein referred to as "Rodriguez").

As per independent claim 1, Cookson (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 9; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; & col. 7, ll. 1-67) shows:

"A method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network . . . producing an

advertising digital music file . . . of a record of a cooperating record corporation . . . [and] distributing the advertising digital music file through the communication network."

Cookson lacks an explicit recitation of "producing an advertising digital music file by deteriorating or damaging a sound quality of an original music file. . . ."

Rodriguez (col. 45, ll. 23-35; and col. 49, ll. 28-38) discloses: *"Another of the data fields that can be included in an audio watermark specifies technical playback parameters. For example. . . . the parameter can invoke special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* In this case, the Examiner interprets *"special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* as showing "producing an advertising digital music file by deteriorating or damaging a sound quality of an original music file. . . ."

Rodriguez proposes sound quality damaging modifications that would have applied to the system of Cookson. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Rodriguez with the teaching of Cookson because such combination would have provided *"a copy-protection scheme . . .* [used in conjunction with] *laws . . . such as those that exist in the United States . . . that would make it a crime to foil a player designed to protect against play of pirated music. . . ."* (See Cookson (col. 2, ll. 1-10)).

As per dependent claims 2-5, Cookson in view of Rodriguez shows the method of claim 1.

Cookson (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 9; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; & col. 7, ll. 1-67) shows elements that suggest the elements and limitations of claims 2-5.

Cookson lacks explicit recitation of the "voice", "sampling rate", "distorting the waveform", and "multi" to "single-channel" limitations of claims 2-5.

Rodriguez (col. 45, ll. 23-35; and col. 49, ll. 28-38) discloses: *"Another of the data fields that can be included in an audio watermark specifies technical playback parameters. For example. . . . the parameter can invoke special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* In this case, the Examiner interprets *"special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* as showing "producing an advertising digital music file by deteriorating or damaging a sound quality of an original music file. . . ."

Rodriguez proposes sound quality damaging modifications that would have applied to the system of Cookson. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Rodriguez with the teaching of Cookson to derive the elements and limitations of claims 2-5 at issue because such combination would have provided *"a copy-protection scheme . . .* [used in conjunction

with] *laws . . . such as those that exist in the United States . . . that would make it a crime to foil a player designed to protect against play of pirated music. . . .*" (See Cookson (col. 2, ll. 1-10)).

As per independent claim 6, Cookson (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 9; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; & col. 7, ll. 1-67) shows:

"A method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network . . . collecting an illegally produced digital music file which is derived from a record of a cooperating record corporation . . . searching the communication network . . . [and] distributing the edited digital music file through the communication network."

Cookson lacks an explicit recitation of "editing the collected digital music file to deteriorate or damage the sound quality of it. . . ."

Rodriguez (col. 45, ll. 23-35; and col. 49, ll. 28-38) discloses: *"Another of the data fields that can be included in an audio watermark specifies technical playback parameters. For example. . . . the parameter can invoke special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* In this case, the Examiner interprets *"special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* as

showing "editing the collected digital music file to deteriorate or damage the sound quality of it. . . ."

Rodriguez proposes sound quality damaging modifications that would have applied to the system of Cookson. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Rodriguez with the teaching of Cookson because such combination would have provided *"a copy-protection scheme . . .* [used in conjunction with] *laws . . . such as those that exist in the United States . . . that would make it a crime to foil a player designed to protect against play of pirated music. . . ."* (See Cookson (col. 2, ll. 1-10)).

As per dependent claims 7-10, Cookson in view of Rodriguez shows the method of claim 6.

Cookson (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 9; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; & col. 7, ll. 1-67) shows elements that suggest the elements and limitations of claims 7-10.

Cookson lacks explicit recitation of the "voice", "sampling rate", "distorting the waveform", and "multi" to "single-channel" limitations of claims 7-10.

Rodriguez (col. 45, ll. 23-35; and col. 49, ll. 28-38) discloses: *"Another of the data fields that can be included in an audio watermark specifies technical playback*

parameters. For example. . . . the parameter can invoke special-effects provided by the playback appliance, e.g., echo effects, reverb, etc." In this case, the Examiner interprets *"special-effects provided by the playback appliance, e.g., echo effects, reverb, etc."* as showing "producing an advertising digital music file by deteriorating or damaging a sound quality of an original music file. . . ."

Rodriguez proposes sound quality damaging modifications that would have applied to the system of Cookson. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Rodriguez with the teaching of Cookson to derive the elements and limitations of claims 7-10 at issue because such combination would have provided *"a copy-protection scheme . . .* [used in conjunction with] *laws . . . such as those that exist in the United States . . . that would make it a crime to foil a player designed to protect against play of pirated music. . . ."* (See Cookson (col. 2, ll. 1-10)).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young
Primary Patent Examiner

January 22, 2004